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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,454	01/11/2002	Dennis M. Smid	DSMID 3.0-001 RE	8257
530 7590 02/12/2010 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER				
CANFIELD, ROBERT				
ART UNIT		PAPER NUMBER		
3635				
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02/12/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/043,454

**Applicant(s)**

SMID ET AL.

**Examiner**

ROBERT J. CANFIELD

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-8, 10-14, 18-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8, 10-14, 18-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/11/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. This Office action is in response to the amendment filed 08/03/09. The status of the claims is as follows:

- a. Claim 1 was canceled in the amendment filed 07/19/05,
- b. Claim 2 stands pending as amended 07/19/05,
- c. Claims 3 and 4 are pending as originally filed,
- d. Claims 5 and 6 stand pending as amended 07/19/05,
- e. Claims 7 and 8 stand pending as amended 08/03/09,
- f. Claim 9 was canceled in the amendment filed 07/19/05,
- g. Claims 10-14 stand pending as amended 07/19/05,
- h. Claims 15-17 were canceled in the amendment filed 07/15/05,
- i. Claims 18-21 stand pending as amended 08/03/09,
- j. Claim 22 was canceled in the amendment filed 07/19/05, and
- k. Claims 23-28 stand pending as amended 08/03/09.

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,012,255 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. The replacement drawing sheet filed 03/06/09 is accepted.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of the second set of lines being spaced differently than the first set of lines and the first characteristic being a solid line and the second characteristic being dotted lines must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "any value up to 2 inches" is of a different scope than what the original disclosure supports and it includes distances not disclosed.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-8, 10, 18-21, 24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,858,402 to Putz.

Putz provides gypsum plasterboards being provided with scaled transverse and longitudinal lines 2 and 3 marked to indicate fixing points for receiving fasteners.

Column 3, line 8 and 9 note that the graduations may consist of grid lines connecting adjacent scales.

Putz fails to provide that the lines are spaced a distance which is 2 inches or less of have value up to 2 inches there between.

The particular claimed spacing of the scaled markings is viewed an obvious choice of design. It would have been obvious at the time of the invention to one having ordinary skill in the art that the lines or markings 2, 3 provided by Putz could have been spaced at any value up to 2 inches as it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. One of ordinary skill in the art would have readily recognized at the time of the invention that the spacing could have been adjusted as desired to provide an indicia to meet a particular need. There would have been no unexpected or unpredictable results achieved by changing the distance of the spacing of the parallel lines of markings of Putz or by making the scaled spacing of the transverse lines different from that of the longitudinal lines. Further, the teachings of Putz would perform the same scaled up or scaled down. Putz even suggests that the markings could

be suitably selected at column 1, lines 59+ where he states that there is no restriction regarding the markings.

With regards to claims 6 and 11, one of ordinary skill in art at the time of the invention would have readily recognized that the teachings of Putz could have been applied to a panel such as plywood or particular board equally well and without any unexpected or unpredictable results. Further, note that it was known at the time of the invention to provide reference markings on plywood [Berg 4,972,696].

9. Claims 2-4 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,858,402 to Putz in view of U.S. Patent 4,927,696 to Berg.

Putz provides each of the elements of the instant claims as noted about except that the first set of markings have a different characteristic than the second set of markings.

Berg teaches that at the time of the invention it was known to make two different sets of marking clearly distinguishable from one another (column 1, lines 65+).

It would have been obvious at the time of the invention to one having ordinary skill in the art that the longitudinal and transverse lines of Putz could have been coded to have been clearly distinguishable from another as taught by Berg. The use of color or dotted vs. dashed lines would have been obvious means of distinguishing the lines from one another and

there would have been no unexpected or unpredictable results obtained by differentiating the markings of Putz by color or design.

10. Claims 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,270,419 to Debo.

Debo provides a covering panel or wallboard 3 provided with a number of marks 13 arranged in substantially parallel lines and placed from one end of the panel to an opposite end thereof in a direction transverse to the extent of the lines. The marks are for facilitation the attaching of the panel to supports. The marks are the only lines shown on the panel.

Debo fails to provide that the lines are spaced a distance which has any value up to 2 inches there between.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the lines or markings 13 provided by Debo could have been spaced at any value up to 2 inches as it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. One of ordinary skill in the art would have readily recognized at the time of the invention that the spacing could have been adjusted as desired to provide an indicia to meet a particular need. There would have been no unexpected or unpredictable results



achieved by changing the distance of the spacing of the parallel lines of markings of Debo. Further, the teachings of Debo would perform the same scaled up or scaled down.

11. There was no supplemental declaration filed with the amendment received 08/03/09 as indicated in applicant's remarks. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 2-8, 10-14, 18-21 and 23-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. CANFIELD whose telephone number is (571)272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rich Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
Art Unit 3635

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